

Application Serial No.: 10/619,253
DOCKET NO.: 4042.3007 US (ISPH-0590US.P1)

REMARKS

Applicants would like to thank Examiners Vivlemore and Schultz for the courteous personal interview granted February 28, 2006, to Applicants' representatives Jodi Connolly and Jason Ferrone.

Following entry of the amendments submitted herewith, Claims 1, 2, 4-11, 21, 24-29, 31-32, and 34-38 will be pending in the instant application.

Claims 1, 2, 4-11, 21, and 36 are currently amended. Support for these amendments can be found throughout the specification, including the claims as originally filed. For example, as described in detail below, support can be found at pages 12, 16, and in Table 2. Support for newly introduced Claim 38 is found in the claims as originally filed, as well as in Table 2. Accordingly, no new matter has been added to this application.

Claims 3, 12-20, 22, 23, 30, and 33 are canceled without prejudice to presentation of the subject matter of these claims in one or more continuing applications.

Claims 24-33, 34, 35, and 37 are withdrawn from further consideration by the Examiner. Applicants note that while Claim 34 (newly introduced in the response filed September 27, 2005) was not addressed on page 4 of the Office Action mailed December 16, 2005, it was listed as withdrawn from consideration in the Office Action Summary. As such, Claim 34 has been marked as withdrawn.

Double Patenting

The Examiner provisionally rejected Claims 1, 2, 4-10, 13, 19-22, and 36 under 35 U.S.C. 101 as claiming the same invention as that of Claims 1, 2, 4-13, and 21 of copending Application No. 10/484,442. Additionally, the Examiner provisionally rejected Claims 1-10, 13, 18-23, and 36 on the ground of nonstatutory obviousness-type double patenting as being unpatentable over Claims 1, 4-10, 12, and 13 of copending Application No. 09/918,187. Similarly, the Examiner provisionally rejected Claims 3, 11, 12, 16-18, 20 and 23 on the ground of nonstatutory obviousness-type double patenting as being unpatentable over Claims 1, 2, 4-14, 21, 24 and 25 of copending Application No. 10/484,442. Applicants note the Examiner's provisional double patenting rejections and will address these rejections upon indication of allowability of the present claims.

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Rejection under 35 U.S.C. § 112

The Examiner rejected Claim 12 under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. As stated by the Examiner, Claim 12 is directed to the compound of claim 2 that is defined by the function of being able to inhibit expression of stearoyl-CoA desaturase by 90% in a suitable assay. The Examiner asserted that while the specification teaches in Table 2 numerous antisense sequences directed to human stearoyl CoA desaturase that demonstrate inhibition of gene expression ranging from 0 to 93%, the specification “does not disclose, nor is it known in the prior art, the structure of an antisense targeted to human stearoyl CoA-desaturase that corresponds to a 90% inhibition of gene expression.” Applicants respectfully disagree. Disclosed in Table 2 are several antisense oligonucleotides that fall within the scope of Claim 12, i.e. these antisense oligonucleotides inhibit the expression of human stearoyl CoA desaturase by at least 90% in a suitable assay. However, solely in an effort to advance prosecution, Applicants have canceled Claim 12 and respectfully request withdrawal of this rejection.

Rejections under 35 U.S.C. § 102/103

The Examiner rejected Claims 1, 2, 19 and 21 under 35 U.S.C. § 102(b) as being anticipated by Stenn et al. As Claim 19 has been canceled, this rejection is currently relevant to Claims 1, 2, and 21. Additionally, the Examiner rejected Claims 1-12 and 17-23 under 35 U.S.C. § 102(b) as anticipated by or, in the alternative, under 35 U.S.C. § 103(a) as obvious over Monia et al. As Claims 3, 12, 17, 18, 19, 20, 22, and 23 have been canceled, this rejection is currently relevant to Claims 1, 2, 4-11, and 21. With respect to these claims, only Claim 1 is independent.

Claim 1 has been amended to recite antisense compounds that “specifically hybridize to a sequence within the range of nucleotides 2989 to 3054 of SEQ ID NO: 3 with at least 90% complementarity”. Support for these amendments is found throughout the specification. Specifically, support for the range “15 to 25 nucleobases” is found on page 16, lines 2-6. Support for the nucleotide range 2989 to 3054 of SEQ ID NO: 3 is found in the target regions of four antisense oligonucleotides illustrated in Table 2, which

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are overlapping or nearly overlapping. Specifically, SEQ ID NO: 29 hybridizes beginning at nucleotide 2989 of SEQ ID NO: 3 and ending at nucleotide 3008, SEQ ID NO: 30 hybridizes beginning at nucleotide 3011 and ending at nucleotide 3030 of SEQ ID NO: 3, SEQ ID NO: 124 hybridizes beginning at nucleotide 3020 and ending at nucleotide 3039 of SEQ ID NO: 3, and SEQ ID NO: 125 hybridizes beginning at nucleotide 3035 and ending at nucleotide 3054 of SEQ ID NO: 3. Support for “90% complementarity” can be found at page 12, lines 3-6.

Neither Stenn et al. nor Monia et al. disclose targeting nucleotides 2989 to 3054 of SEQ ID NO: 3 with antisense compounds. Furthermore, neither reference discloses the sequence of an antisense compound that would specifically hybridize with at least 90% complementarity to a sequence within this range of SEQ ID NO: 3. Thus, Stenn et al. does not anticipate currently amended Claim 1 or the claims dependent therefrom. Additionally, Monia et al. does not anticipate, or render obvious, currently amended Claim 1 or the claims dependent therefrom. As such, Applicants respectfully request that the Examiner withdraw the rejection of Claims 1, 2, 4-11, and 21 under 35 U.S.C. § 102/103. The rejection of Claims 3, 12, 17, 18, 19, 20, 22, and 23 is obviated as these claims have been canceled.

Rejection under 35 U.S.C. § 103

The Examiner rejected Claims 1-12 and 16-23 under 35 U.S.C. § 103(a) as being unpatentable over Stenn et al. and further in view of Taylor et al., Baracchini et al., and Bennett et al., for the reasons of record set forth in the Office Action mailed December 16, 2006. Applicants respectfully disagree.

As Claims 3, 12, 16-20, 22, and 23 are canceled, this rejection is currently relevant to Claims 1, 2, 4-11, and 21. Of these claims, Claim 1 is the only independent claim.

In view of the current amendments to Claim 1, particularly the addition of the limitation that the antisense compounds “specifically hybridize with a sequence in the range of nucleotides 2989 to 3054 of SEQ ID NO: 3”, Applicants respectfully submit that this rejection is rendered improper because the cited references neither alone or in combination teach or suggest all of the limitations of Claim 1 or the claims depending

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therefrom. Accordingly, the combination of the cited references does not render the pending claims obvious. As such, Applicants respectfully request that the Examiner withdraw the rejection of Claims 1,2, 4-11, and 21 under 35 U.S.C. § 103(a). The rejection of Claims 3, 12, 16-20, 22, and 23 is obviated as these claims have been canceled.

Allowable Subject Matter

Applicants note that the Examiner stated SEQ ID NO: 30 is free of the prior art.

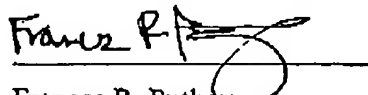
CONCLUSION

Applicants believe that the foregoing comprises a full and complete response to the Office Action of record and that the present claims are in condition for allowance. Nevertheless, if any issues remain or require clarification, the Examiner is invited to contact the undersigned at the telephone number provided below in order to expedite resolution of such issues.

The Director is hereby authorized to charge any deficiency in any fees due with the filing of this paper or during the pendency of this application, or credit any overpayment in any fees to our Direct Account Number 50-0252, referencing Docket No. ISPH-0590US.P1.

Respectfully submitted,

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